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REMARKS

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Claims 1-11 and 41-49 are currently pending in the subject application and are presently under consideration. Claim 1 has been amended as shown on pp. 2-11 of the Reply to correct the informality noted in the Final Office Action dated April 21, 2006. Entry of the amendment is respectfully requested since it removes issues in the event of an appeal, does not require further searching, and/or places the subject application in condition for allowance

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I.   **Rejection of Claims 1-10 and 41-49 Under 35 U.S.C. §102(e)**

Claims 1-10 and 41-49 stand rejected under 35 U.S.C. §102(e) as being anticipated by Morgan *et al.* (U.S. Patent 6,073,140). It is respectfully requested that this rejection be withdrawn for at least the following reason. Morgan *et al.* does not teach or suggest each and every limitation as recited in the subject claims.

> A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The subject invention generally relates to creating an electronic shopping list (*e.g.*, a list of references to items) for a user and utilizing this list to purchase items for the user over the Internet. (*See* Application, p.2, ll.9-11). The systems and methods of the present invention provide a user interface that enables the user to create a personalized list of references to items (*e.g.*, offers, product categories, products from merchants, products from manufacturers...) by electronically selecting and adding such items to their list. (*See* Application, p.2, ll.11-17). This list of references, as well as other users' lists, is stored within an item list database (*See* Application, p.2, ll.17-18). Information related to items is stored within an item database(s) (*See* Application, p.6, ll.7-17). In general, an owner of an item list or a customer who intends on purchasing an item for this owner can request the stored list. On request, an interface component

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utilizes item references from the stored list to extract related item data from the item database and employs the extracted data to present a list of items to a requester including current information from the item database. (*See* Application, p.7, ll.5-10).

Independent claim 1 recites an item database holding information with respect to items and an item list database that stores an item list that includes a reference to at least one item associated with the information stored in the item database. Claim 1 also recites an interface component that *receives a request to display the item that is referenced in the item list, accesses the item list database to obtain the reference from the item list, utilizes the reference as a key into the item database and retrieves data corresponding to the referenced item from the item database.* The interface component utilizes the retrieved data to display the item and associated information to the requester. Similarly, independent claim 41 recites an item list including a reference to an item stored in an item database, where the *reference is utilized as a key into the item database to extract data corresponding to the referenced item from the item database and to display the referenced item and associated information.* In addition, independent claim 47 recites a means for *receiving a request to display the referenced item, retrieving the reference, utilizing the reference as a key into the stored information, extracting data corresponding to the referenced item and utilizing the extracted data to display the item and associated information to the requester.* In claims 1, 41 and 47, the requester is presented with a list of items and associated information dynamically updated to reflect changes in the underlying item database. Morgan *et al.* does not describe, teach or suggest such claimed aspects.

Morgan *et al.* is directed to a system for creating or updating a retailer's customer list database with information from a data vendor's central database or set of databases. Organizations such as insurance companies, credit card issuers and retailers maintain lists of current or target customers, which can be used in preparing mailing lists. These customer lists or customer databases can be created or enhanced using data imported from a data vendor. Data vendors can provide additional, information relating to large numbers of individuals or companies. (Col.1, ll.35-37). The system described in Morgan *et al.* utilizes persistent keys to link the customer database to the central database and allow data from the central database to be overlaid or copied onto the customer database. (Col.1, ll.10-14). Data is periodically copied from the central database to customer databases where it can be accessed and used to generate mailing lists. There is no indication that the central database is accessed by an interface

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component in response to a request to display data and that retrieved data is utilized to display an item and associated information to a user. In contrast, Morgan *et al.* discusses updating the customer lists on a periodic basis (*e.g.*, weekly) and describes the advantages of this increased frequency in transfer of data to the customer database. (Col.6, ll.12-19). Morgan *et al.* fails to disclose the dynamic extraction of data from a central database to display an updated customer list on request.

The use of references stored in an item list to extract information from an item database for display of an item provides several advantages. By utilizing references to items to extract items from the item database rather than simply copying the data into the item list database on a periodic basis, the system ensures that the displayed item information is current. Modifications to the item database will be automatically reflected when the item lists are displayed to users. For example, if the price of an item is increased in an item database, the increased price will be automatically retrieved from the information database when item lists are displayed to users without requiring a separate update of effected item lists. In contrast, in the system described in Morgan, *et al.* when information contained in the central database is modified after the customer list is generated or updated, the information in the customer list may be incorrect.

The subject application is focused upon an electronic shopping list for use over the Internet. Independent claims 1 and 47 each describe systems that *facilitate electronic shopping through an electronic item list for items residing on the Internet*. Similarly, claim 41 describes a method for providing *an electronic item list for items residing on the Internet*. In contrast, Morgan *et al.* is focused on provision of information to be used in lists of customers. The lists or databases described in Morgan *et al.* are used to manage groups of prospective customers and contain individuals and their associated demographic information. (Col.1, ll.7-12, 50-65). Morgan *et al.* fails to disclose or suggest an item list for electronic shopping.

Independent claims 1, 41 and 43 each recite an item database or means for storing information with respect to items, where the information is *at least one of an offer type, a general product type, a specific manufacturer type and a specific merchant type*. Offer type information can include offers for items for sale by merchants. A general product type can include a category or class of item. Manufacturer type information includes the manufacturer of an item and merchant type information includes a merchant or retailer who offers the item for sale. (*See* Application p. 6, ll. 7-11). Such item information is displayed in response to a request

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to display the item. Morgan *et al.* does not describe, teach or suggest storage and/or display of such item information. The central database of Morgan *et al.* includes customer information or demographics (*e.g.*, name, geographic location, marital status and income).

Claim 2 recites the *interface component degrades the display of the item as records are removed from the item database,* claim 42 recites *degrading the display of the item as records are removed from the item database and* claim 48 recites *means for degrading the display of the item as records are removed from the stored information.* As disclosed in the subject application, when an item in a user's item list is removed from the item database, the data can be degraded to provide a user with an alternate item from the database and/or another database, such as the best available item. Such degrading can provide a user with a link to a merchant's web site or to other items. (*See* Application, p.7, ll.12-24). Morgan *et al.* does not discuss removal of information contained in the central database and degrading of display of such information. Accordingly, Morgan *et al.* does not teach or suggest degrading items on a list when the items are removed from the database, as recited in the subject claim.

Claim 5 recites *a remote input component that allows a user to add an item to the item list, the item is a description that resides on a remote merchant's site.* Similarly, claim 45 recites *allowing a user to select an item from an electronic website to add to the item list and adding the selected item to the item list.* Morgan *et al.* does not teach or suggest adding customers from either websites or remote merchant's sites. Morgan *et al.* only describes adding to a customer list by enhancing the customer list using the central database.

Claim 8 recites *a component that links an infrastructure of the item list system to a remote site, the item list system appears to reside on the remote site.* As disclosed in the subject application, a remote merchant site can be linked to a shopping portal with a database that stores items from a plurality of merchants. When a user at the remote merchant site requests to view items, the items can be filtered such that only items associated with the remote site are returned to the user. Thus, only products from the remote merchant can be added to the item list through the merchant's site. (*See* application, p.14, ll. 10-26). Morgan *et al.* does not teach or suggest a component that links an item list infrastructure to a remote site such that it appears to a user that the item list resides at the remote site when it does not.

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In addition, claims 2-10 depend from claim 1. As discussed *supra*, Morgan *et al.* does not teach or suggest all limitations of claim 1. For at least these reasons, the rejection to claims 1-10 should be withdrawn.

II.   Rejection of Claim 11 Under 35 U.S.C. §103(a)

Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Morgan *et al.* in view of Kalagnanam *et al.* (U.S. Patent 6,873,967). It is respectfully requested that the rejection should be withdrawn for at least the following reason. Neither Morgan *et al.* or Kalagnanam *et al.*, alone or in combination, teach or suggest all limitations as recited in the subject claims.

> To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *See In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As discussed *supra,* Morgan *et al.* does not teach or suggest all limitations recited in independent claim 1, from which claim 11 depends. In addition, Kalagnanam *et al.* fails to make up for the aforementioned deficiencies of Morgan *et al.* Both Morgan *et al.* and Kalagnanam *et al.* fail to disclose dynamic update and display of an item list from an item database based upon request to display. Therefore, withdrawal of this rejection is requested.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP151US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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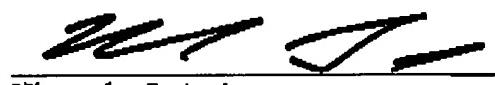
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